

**R E M A R K S**

Reconsideration of the application in view of the following remarks is respectfully requested. No claims are currently being amended, canceled or added. Therefore, claims 1-35 and 37-51 are pending in the application.

**Advisory Action Requested**

If this response does not result in a Notice of Allowance, Applicant hereby requests a timely Advisory Action. This response is being filed within two months of the mailing date of the Final Action.

**Claim Rejections under 35 U.S.C. § 103**

Claims 1-35 and 37-51 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,321,188 to Hayashi et al. ("Hayashi et al.") in view of U.S. Patent Application Publication No. 2002/0093435 A1 to Baron ("Baron"). Applicant respectfully traverses these rejections.

With respect to independent claims 1, 20, 37, 43 and 49, Applicant argued in his last amendment that Hayashi et al. does not disclose or suggest all of the steps in Applicant's independent claims being performed by a communication device that comprises a single unit. Instead, Hayashi et al. discloses two separate devices, namely apparatus 1 and apparatus 2 as illustrated in FIGS. 7A-7H. As described, Japanese phrases are selected in apparatus 1, and English phrases are output from apparatus 2. That is, such operations are not performed by a single unit, as is now required by Applicant's claims.

In the latest office action the Examiner acknowledges that Hayashi et al. does not teach the communication device

comprises a single unit. As such, the Examiner asserts that Baron teaches a communication device is a single unit and that it would be obvious to combine the teachings of Hayashi et al. with the communication device of Baron. (Final Office Action mailed 4/20/06, page 3, lines 11-17).

With this argument the Examiner is presumably proposing that it would be obvious to a person having ordinary skill in the art to somehow modify Hayashi et al.'s system so that the operations performed by apparatus 1 and apparatus 2 are instead all performed by a single unit. Applicant asserts that there would be no motivation for a person of ordinary skill in the art to make such a modification for the following reasons.

**I. The Proposed Modifications Would Render Hayashi et al. Unsatisfactory for its Intended Purpose:**

Section 2143.01 of the Manual of Patenting Examining Procedure (MPEP) states:

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)."

MPEP § 2143.01 Suggestion or Motivation To Modify the References.

Applicant asserts that modifying Hayashi et al.'s system so that the operations performed by apparatus 1 and apparatus 2 are instead all performed by a single unit would render Hayashi et al.'s system unsatisfactory for its intended purpose.

Namely, Hayashi et al. state that an object of their invention "is to provide a language-information providing

apparatus which is capable of providing positive communication between users having different languages as their mother tongues and located in mutually remote places, by making use of a telephone line or the like." (Hayashi et al., col. 2, lines 35-41) (emphasis added). Furthermore, with respect to Hayashi et al.'s apparatus 1 and apparatus 2, Hayashi et al. state that "FIGS. 7A to 7H are diagrams explaining the operation modes for effecting communication between users in mutually remote places by connecting two apparatuses via a telephone line." (Hayashi et al., col. 2, lines 35-41) (emphasis added). And in addition to the above-quoted language, Hayashi et al. repeatedly describe effecting communication with a user in a remote place.

Clearly, Hayashi et al. implement their object of effecting communication between users in mutually remote places by having apparatus 1 located in one place and the separate apparatus 2 located in the other remote place with the two apparatuses being connected via a telephone line. As described with respect to Hayashi et al.'s FIGS. 7A-7H, Japanese phrases are selected in apparatus 1 in one place, and English phrases are output from apparatus 2 in the remote place.

Applicant asserts that modifying Hayashi et al.'s system so that the operations performed by apparatus 1 and apparatus 2 are instead all performed by a single unit would render Hayashi et al.'s system unsatisfactory for its intended purpose of effecting communication between users in mutually remote places. This is because performance of all of Hayashi et al.'s operations in a single unit in one place will not effect communication between users in mutually remote places. For example, selecting Japanese phrases in a single unit in one place, and then outputting English phrases from the same

single unit in the same place does not effect communication between users in mutually remote places.

Therefore, because the proposed modifications to Hayashi et al.'s system would render it unsatisfactory for its intended purpose, a person having ordinary skill in the art would not be motivated to make such modifications.

## **II. Hayashi et al. Teaches Away from the Proposed Modifications:**

Another reason it would not be obvious for a person having ordinary skill in the art to make the proposed modifications to Hayashi et al.'s system is that Hayashi et al. teaches away from the proposed modifications.

Namely, as described above Hayashi et al. teaches effecting communication between users in mutually remote places by having apparatus 1 located in one place and the separate apparatus 2 located in the other remote place with the two apparatuses being connected via a telephone line. Hayashi et al.'s teaching of effecting communication between remote places by having two separate apparatuses located in the different places teaches directly against modifying Hayashi et al.'s system so that the operations performed by apparatus 1 and apparatus 2 are instead all performed by a single unit. Quite simply, Hayashi et al.'s teaching of the need for two separate apparatuses located in the different places teaches directly against combining the operations in a single unit which can only be at one place. Furthermore, a person of ordinary skill in the art would not ignore Hayashi et al.'s purpose of effecting communication between users in remote places which relies on two separate apparatuses located in the different places.

Therefore, because Hayashi et al. teaches against the

proposed modifications, a person having ordinary skill in the art would not be motivated to make such modifications.

**III. Baron Provides No Motivation to Make the Proposed Modifications:**

Another reason it would not be obvious for a person having ordinary skill in the art to make the proposed modifications to Hayashi et al.'s system is that Baron provides absolutely no motivation to make such modifications.

Namely, Baron is directed to an electronic tour guide and photo location finder. The portions of Baron cited by the Examiner indicate that an object of Baron's invention is to provide a portable positioning system adapted to provide a user with information about nearby sites and information for locating a photo-spot. (Baron, page 2, paragraphs [0013] to [0016]). There is nothing in Baron regarding communication between users of different languages. Furthermore, there is nothing in Baron regarding language translation.

Because Baron's electronic tour guide and photo location finder has a function and purpose that is completely unrelated to that of Hayashi et al.'s system, there is nothing in Baron that would motivate a person having ordinary skill in the art to modify Hayashi et al.'s system so that the operations performed by apparatus 1 and apparatus 2 in effecting communication between users in remote places are instead all performed by a single unit. This is because Baron is directed to an electronic tour guide and photo location finder and teaches nothing about communication between users of different languages. Furthermore, there is nothing in Baron suggesting that the operations performed by Hayashi et al.'s apparatus 1 and apparatus 2 should all be performed by a single unit, especially given that Hayashi et al.'s purpose is to effect

communication between users in mutually remote places. That is, there is nothing in Baron that would motivate a person having ordinary skill in the art to ignore Hayashi et al.'s purpose of effecting communication between users in mutually remote places and modify Hayashi et al.'s system so that the operations performed by apparatus 1 and apparatus 2 are instead all performed by a single unit.

Therefore, because the Baron provides no motivation to make the proposed modifications to Hayashi et al.'s system, a person having ordinary skill in the art would not be motivated to make such modifications.

#### **IV. Independent Claim 49:**

In addition, the Examiner rejected Applicant's independent claim 49 on the basis of Hayashi et al.'s col. 16, lines 44-53. ***As Applicant has previously pointed out this portion of Hayashi et al. simply does not disclose all of the limitations of Applicant's independent claim 49.*** This is another reason that the rejection of independent claim 49 should be withdrawn.

#### **V. Summary:**

For all of the above reasons Applicant submits that a *prima facie* case of obviousness of Applicant's independent claims 1, 20, 37, 43 and 49 has not been established and the rejections should be withdrawn. Furthermore, the rejections of all of the dependent claims should also be withdrawn for at least the above reasons due to their dependence on their respective independent claims.

No Fees Believed to be Due

No extra claims fees are believed to be due.


C O N C L U S I O N

In view of the above, Applicant submits that the pending claims are in condition for allowance. Should there remain any outstanding issues that require adverse action, it is respectfully requested that the Examiner telephone Richard E. Wawrzyniak at (858)552-1311 so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,

Dated

6/19/06

  
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